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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/022,728 | 12/20/2001 | Qixu Chen | 146712002800 | 5591 |
| 25227 | 7590 | 01/14/2004 | EXAMINER | |
| MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 300 MCLEAN, VA 22102 | | | BERNATZ, KEVIN M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1773 | |

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/022,728

Applicant(s)

CHEN ET AL.

Examiner

Kevin M Bernatz

Art Unit

1773

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 1 and 3-19.Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 5. does NOT place the application in condition for allowance because: applicants argue that Wang et al. does not qualify as prior art and that applicants' alleged admissions are therefore not shown to be known to one of ordinary skill at the time of applicants' invention. The Examiner respectfully disagrees.

The Examiner notes that Wang et al. qualifies as prior art since the filing date of Wang et al. (12/22/2000) preceeds applicants' effective filing date (3/7/2001). Whether Wang et al. is relied upon in an evidentiary manner or as the basis of a rejection, the filing date of Wang et al. is sufficient to qualify as prior art since it was filed prior to the time of applicants' invention. See MPEP 2136 for the use of filing dates of U.S. published applications to a different inventive entity.

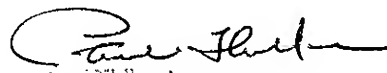
Regarding applicants' arguments in terms of what Bian et al. disclose, the Examiner notes that the confusion appears to be based upon the assumption by applicants that Bian et al. teaches an isotropic (i.e. $OR=1.0$) medium. Both applicants and the Examiner agree that Bian et al. does not explicitly mention an $OR>1.0$ (i.e. an "oriented medium"), and that Bian et al. refers to a "longitudinal medium".

It is the Examiner's position that since Bian et al. does not explicitly mention that the medium is either oriented /or/ isotropic, that neither can be assumed. As such, the Examiner has cited art to provide motivation as to why an oriented longitudinal medium is desirable. The Examiner appreciates applicants' drawings illustrating the differences between "longitudinal", "perpendicular", "oriented" and "isotropic" and notes that oriented media are primarily associated with longitudinal media since perpendicular media do not possess major anisotropy in either of the radial or circumferential directions.

Finally, applicants argue that the $Mrt-OR$ greater than 1.05 would not necessarily be expected (and hence, qualify as unexpected results) based just upon a texturing of the substrate/coating layer. The Examiner respectfully disagrees.

As illustrated in the prior art of record, texturing the substrate surface is known to increase the OR ratio and is a known method of forming oriented media. One of ordinary skill in the art would be deemed to possess the knowledge of how to produce oriented media, which are known in the art, and one such method is via circumferential texturing. While other factors influence the OR ratio or whether a medium is oriented or isotropic, the basis of an expected result does not require an inherency-type requirement. One of ordinary skill in the art would possess the knowledge to optimize the different types of textures and crystallographic orientations to produce an oriented longitudinal medium if such a medium was desired and one of ordinary skill in the art would expect that the use of texturing with a longitudinal Co-based magnetic alloy would produce a highly oriented medium.

Wang
1/8/04


Paul Thibodeau
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